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EXAMINER

KOLLIAS, ALEXANDER C

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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Applicant's amendment filed on 7/15/2009 has been entered. Applicant's arguments have been fully considered but are not persuasive for the reasons set forth below.

Applicant's arguments of unexpected results regarding the size of powder coating of the powder coating particles, i.e., the powder coating particle of powder (B) are less than 35 mm and the particles of (A) are with $\pm 15\%$ the average of (B), in terms of lack of hiding and finishing appearance. However, Applicant's arguments regarding unexpected results of Example 1 compared to 2 and Example 4 compared to 5 are not found to be convincing for the following reasons.

Although Examples 1 and 2 and Example 4 and 5 are proper side by side comparisons, it is noted that Examples 2 and 5 have a particle size of 18 microns, it is noted that the examples do not disclose the entire range claimed, i.e. less than 25 microns. Furthermore, the difference in particle sizes of powders A and B in these examples is zero, i.e., the powders A and B have the same particle sizes, while the present claims recite a difference of $\pm 15\%$. As set forth in MPEP 716.02(d), whether unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, "objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support". In other words, the showing of unexpected results must be reviewed to see if the results occurred over the entire claimed range, *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980).

Art Unit: 1796

Applicants have not provided data to show that the unexpected results do in fact occur over the entire claimed range of particle sizes and derivation in particle sizes presently recited.

It is noted that the present claims recite that powder coating (A) is a resin having hydroxyl groups, while the Examples disclosed in the Specification disclose polyester resin for powders A and B. Therefore the Examples are not commensurate with the scope of the present claims.

Regarding symbols utilized to grade the lack of hiding and finishing appearance of Example 1 compared to Example 2 and Example 4 compared to 5, it is noted that the criteria for determining finishing appearance and lack of hiding are not clear. For example the differences between the finishing appearances of Example 1 compared to Example 2 are defined in the Specification as “flickering due to uneven gloss is not recognizable” and flickering due to uneven gloss is slightly recognizable”. Similarly it is noted that the evaluation criteria for lack of hiding are defined as “mottled patterns due to lack of hiding are not recognizable” and “mottled patterns due to lack of hiding are slightly recognizable”. It is unclear what difference, if any, is there between “not recognizable” and “slightly recognizable”.

Applicant argues that Umehara discloses matte appearance brought about by irregularity of the coating film while Satoh teaches controlling particle size for obtaining a smooth coating. However, it is noted that the Examiner was not combining Satoh with Umehara in order to teach a smooth matte finish film but rather that Satoh et al teaches control of the thermosetting powder particle size affects the smoothness of the finish.

Art Unit: 1796

Applicant argues that Nakamura discloses a solvent based coating and not a powder coating composition and therefore the blocked isocyanate disclosed by the reference cannot be combined with Umehara et al. However, it is noted that while Nakamura does not disclose all the features of the present claimed invention, the reference is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely storage stability of coating compositions containing blocked isocyanates, and in combination with the primary reference, discloses the presently claimed invention. If the secondary reference contained all the features of the present claimed invention, it would be identical to the present claimed invention, and there would be no need for secondary references.

Regarding applicant's argument that Nozaki is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Nozaki teaches the use of blocked isocyanates which are added to coating compositions in order to impart storage stability.

Further Applicant argues that Nakamura though discloses a blocked isocyanate known under the trade name VESTANAT B 1358/100, this compound is not utilized in the example. However, it is noted that "Applicant must look to the whole reference for what it teaches.

Art Unit: 1796

Applicant cannot merely rely on the examples and argue that the reference did not teach others.”

In re Courtright, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967).

Applicant argues that Itakura does not disclose differentiating reactivity of powder coatings and obtaining a matte finish by controlling reactivity. However, it is noted that while the reference does not disclose all the features of the present claimed invention, the reference is used as teaching reference, and therefore, it is not necessary for this secondary reference to contain all the features of the presently claimed invention, *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973), *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather this reference teaches a certain concept, namely combining different colored powder coating compositions for the purposes of color matching, and in combination with the primary reference, discloses the presently claimed invention. If the secondary reference contained all the features of the present claimed invention, it would be identical to the present claimed invention, and there would be no need for secondary references.

Applicant argues that Nozaki fails to disclose a powder coating composition for a matte coating film which is obtained by making use of the different dissociation rates of the blocking agents of the blocked isocyanate compounds. However, it is noted that the features upon which applicant relies (i.e., different dissociation rates of the blocking agent) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Art Unit: 1796

With respect to Applicant's request for reconsideration it is noted that if the amendment were entered it is the Examiner's position that the amendment would not overcome the prior art rejections of record given that claim 1 would be rejected over Nakamura in view of Nozuki et al, Ring et al, and Satoh et al. Furthermore, it is noted that were the amendment entered, the claims as amended would overcome the prior rejection of claims 1, 12-14, 16, and 34-36 under 35 U.S.C. first paragraph.

7/17/2009
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